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V8

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/091,538	09/16/98	HERMON-TAYLOR	117-260

HM12/0120

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EXAMINER
BASKAR, F

ART UNIT	PAPER NUMBER
1645	12

DATE MAILED: 01/20/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/091,538

Applicant(s)

TAYLOR ET AL

Examiner

Padma Baskar

Group Art Unit
1645



- ☐ Responsive to communication(s) filed on _____
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

- ☒ Claim(s) 1-11, 13-18, and 20-23 is/are pending in the application.
- Of the above, claim(s) 4-11, 14, 15, 18, and 20-23 is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-3, 13, 16, and 17 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claims _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☒ The drawing(s) filed on Sep 16, 1998 is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☒ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
- ☒ received.
- ☐ received in Application No. (Series Code/Serial Number) _____.
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

- ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- ☐ Notice of References Cited, PTO-892
- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 6
- ☐ Interview Summary, PTO-413
- ☒ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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DETAILED ACTION

1. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy has been filed in parent Application No. 09/091,538 filed on 9/16/1998.

2. Applicant's amendment file on 12/13/99 is acknowledged. Applicant elects with traverse, Group I, claims 1-3 and 16-17. Applicant requests reconsideration and withdrawal of restriction requirements. However, MPEP Rule 1.475 **Unity of invention before the International Searching Authority, the International Preliminary Examining Authority and during the national stage reads the following:**

b. An international or a national stage application containing claims to different categories of invention will be considered to have unity of invention if the claims are drawn only to one of the following combinations of categories: 1. A product and a process specially adapted for the manufacture of said product;

or

2 A product and process of use of said product;

or

3. A product, a process specially adapted for the manufacture of the said product, and a use of the said product;

or

4. A process and an apparatus or means specifically designed for carrying out the said process;

or

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If an application contains claims to more or less than one of the combinations of categories of invention set forth in paragraph (b) of this section, unity of invention might not be present.

If multiple products, processes of manufacture or uses are claimed, the first invention of the category first mentioned in the claims of the application and the first recited invention of each of the other categories related thereto will be considered as the main invention in the claims, see PCT Article 17(3)(a) and § 1.476(c). Accordingly applicants invention falls under many combination of categories of invention and therefore, first product, claims 1-3 and 16-17 and first method of use, claim 13 will be prosecuted in this application.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 1-3, 13 and 16-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 is vague and indefinite for the recitation of "substantially isolated form". What are the metes and bounds of "substantially isolated form"?

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Claim 1 is vague and indefinite for the recitation of “ polypeptide substantially homologous thereto”. What are the polypeptides which are homologous thereto; how much is necessary to be defined as substantially?

Claim 13 is vague and indefinite for the recitation of “ polypeptide substantially homologous thereto”. What are the polypeptides which are homologous thereto; how much is necessary to be defined as substantially?

Claim 17 is vague and indefinite for the recitation of “ polypeptide substantially homologous thereto”. What are the polypeptides which are homologous thereto; how much is necessary to be defined as substantially?

Claim 16 is also rejected because it depends on a rejected claim 17.

Claim 2 is vague and indefinite because it is nothing but the repetition of claim 1.

Claim 3 is vague and indefinite for the recitation of “fragment comprising at least 12 amino acids and an epitope”. Are these fragments epitopes of antigens? Or does this fragment contain an epitope besides 12 amino acids? Or Is this fragment an epitope which has 12 amino acids?

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Padma Baskar whose telephone number is (703) 308-8886. The examiner can normally be reached on Monday through Friday from 6.30 AM to 4 PM EST.

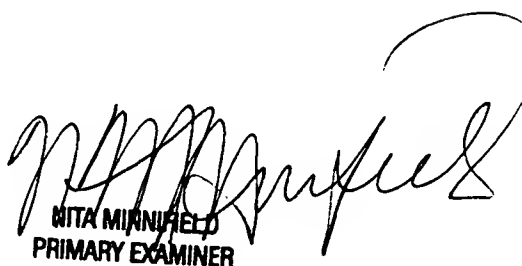
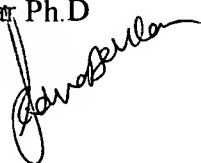
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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Caputa, Ph.D can be reached on (703) 308-3995. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

Padma Baskar Ph.D

1/14/2000



NITA MINNIFIELD
PRIMARY EXAMINER